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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/631,270	08/02/2000	Christopher M. Carpenter	Q00-1000-US1	8515

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EXAMINER

NGUYEN, MINH DIEU T

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/631,270

Applicant(s)

CARPENTER ET AL.

Examiner

Minh Dieu Nguyen

Art Unit

2137

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Claims 1-11 are pending.

Specification

1. The disclosure is objected to because of the following informalities:
 - a) On page 5, line 21, "step 146" should be "step 106" according to Figure

2A.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1 and 2** are rejected under 35 U.S.C. 102(e) as being anticipated by Maenza, US Patent 6,076,165.

a) **As to claim 1**, Maenza discloses a method for embedding a "fingerprint" on each originally-produced, authentic digital storage device and using the embedded fingerprint to eliminate or discourage compact disc pirating. The method comprises:

- determining a unique fingerprint from the source storage medium (Figure 2, col. 3, lines 54-56; lines 62-65)
- combining the content to be secured with the source fingerprint to generate the fingerprinted content (col. 3, lines 19-25)
- instructing the source medium to store the complete data frame which reads on the fingerprinted content (Figure 2; col. 3, lines 25-27).

b) **As to claim 2**, Maenza discloses a method further comprising the step of a processor reading and verifying the fingerprinted content:

- reading the fingerprinted content from a compact disc (Figure 6, step 34)
- separating the content to be secured from the source fingerprint (Figure 6, step 35)
- requesting a local fingerprint from the local medium (Figure 6, step 36)
- comparing the local fingerprint with the source fingerprint and in response to the comparison determining whether to use the source content (col. 5, lines 2-14)

4. **Claims 1-2 and 4** are rejected under 35 U.S.C. 102(e) as being anticipated by Stebbings, US Patent 6,684,199.

a) **As to claim 4**, Stebbings discloses a method and system for preventing piracy and/or unauthorized copying of data from a data source (col. 1, lines 16-24)

Stebbing discloses the step of combining the data which reads on source content and predetermined errors which reads on source fingerprint to generate the hybrid content and encrypting the hybrid content with an encryption key (Figure 11, col. 20, lines 35-67, col. 21, lines 1-4).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 3 and 5-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Stebbings, US Patent 6,684,199 in view of Aucsmith, US Patent 6,148,407.

a) **As to claims 3 and 6**, Stebbings discloses the step of requesting a source fingerprint comprising:

- using an open protocol to request a secured communication from the source medium (Figure 22)

- identifying a predetermined errors (fingerprint) which reads on characteristic associated with the source medium (col. 20, lines 37-40). Stebbings does not disclose the physical, statistically unique, verifiable and relatively immutable (PSUVI) characteristics and non PSUVI characteristics (claims 3 and 6 respectively)
- generating at least one of encryption and decryption keys (col. 20, lines 38-40)
- using the encryption key to convert the source content to an encrypted protocol (Figure 13, element 60)
- requesting from the source medium the PSUVI or non PSUVI (claims 3 and 6 respectively) fingerprint characteristic (Figure 14, element 78) and responding to the host with PSUVI or non-PSUVI fingerprint

Aucsmith discloses a method and apparatus for producing computer platform fingerprints. This "fingerprinting" process is formed by a set of trait values, which classified into a constant trait which reads on PSUVI characteristic (Figure 5) and a membership trait which reads on non-PSUVI characteristic (Figure 6).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of defining these classes of characteristics, as Aucsmith teaches, in the system of Stebbings so as to effectively protect data security in each characteristic system.

b) **As to claims 5 and 7**, Stebbings discloses the step of requesting a local fingerprint from the local storage medium further comprising:

- requesting from the local storage medium a local fingerprint PSUVI and non-PSUVI characteristic (claims 5 and 7 respectively) (Figure 14, element 78). Stebbings does not disclose the physical, statistically unique, verifiable and relatively immutable (PSUVI) characteristic and non PSUVI characteristic
- replying to the host processor with the local fingerprint PSUVI and non-PSUVI and performing a secured verification of the local fingerprint PSUVI and non-PSUVI (claims 5 and 7 respectively) (Figure 16)

Aucsmith discloses a method and apparatus for producing computer platform fingerprints. This "fingerprinting" process is formed by a set of trait values, which classified into a constant trait which reads on PSUVI characteristic (Figure 5) and a membership trait which reads on non-PSUVI characteristic (Figure 6).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of defining these classes of characteristics, as Aucsmith teaches, in the system of Stebbings so as to effectively protect data security in each characteristic system.

c) **As to claims 8 and 9**, Stebbings discloses a system for minimizing pirating and/or unauthorized copying and/or unauthorized access of/to data on/from

data media comprising a host processor (Figure 18) and a storage medium, the storage medium comprising a storage medium processor (col. 24, lines 27-32), a host processor interface, a servo system, a read/write system, one of more storage disks and attribute detector to read storage disc characteristic (Figures 12 and 19).

Stebbing does not disclose the physical, statistically unique, verifiable and relatively immutable (PSUVI) characteristic and non PSUVI characteristic from the one or more storage disks to use by the host processor to encrypt a content to be secured.

Aucsmith discloses a method and apparatus for producing computer platform fingerprints. This "fingerprinting" process is formed by a set of trait values, which classified into a constant trait which reads on PSUVI characteristic (Figure 5) and a membership trait which reads on non-PSUVI characteristic (Figure 6), (claims 8 and 9 respectively).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of defining these classes of characteristics, as Aucsmith teaches, in the system of Stebbings so as to effectively protect data security in each characteristic system.

d) **As to claims 10 and 11**, Stebbings discloses a fingerprinted content comprises a content to be secured combined with a fingerprint generated from a characteristic of the storage medium (Figure 11, element 21). However, Stebbings does not disclose the physical, statistically unique, verifiable and relatively immutable (PSUVI) characteristic and non PSUVI characteristic of the storage medium.

Aucsmith discloses a method and apparatus for producing computer platform fingerprints. This "fingerprinting" process is formed by a set of trait values, which classified into a constant trait which reads on PSUVI characteristic (Figure 5) and a membership trait which reads on non-PSUVI characteristic (Figure 6), (claims 10 and 11 respectively).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of defining these classes of characteristics, as Aucsmith teaches, in the system of Stebbings so as to effectively protect data security in each characteristic system.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

a) Method and System for Preventing Unauthorized Use of Software, Durst, Jr. et al., US Patent 5,113,518.

b) Method and Apparatus for Fingerprinting and Authenticating Various Magnetic Media, Indeck et al., US Patent 5,920,628.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dieu Nguyen whose telephone number is 703-305-9727. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse can be reached on 703-308-4789.

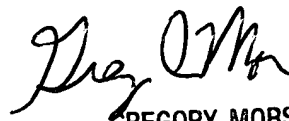
The fax phone numbers for the organization where this application or proceeding is assigned are:

703-746-7238	for After-Final communications
703-872-9306	for Official communications
703-746-5661	for Non-Official/Draft communications

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

mdn
Minh Dieu Nguyen
Examiner
Art Unit 2132

mdn
2/9/04


GREGORY MORSE
SUPERVISORY PATENT EXAMINER
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